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09/853,825	05/10/2001	Todd A. Schelling	10559-416001/P10374	6463

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EXAMINER

SCHUBERT, KEVIN R

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/853,825

Applicant(s)

SCHELLING ET AL.

Examiner

Kevin Schubert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

Claims 1-32 have been considered.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/20/06 has been entered.

#### ***Specification***

The Specification is objected to in accordance with the 112, first paragraph, rejections below.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner does not find the limitation "wherein the system comprises a platform to authenticate the secure message by the BIOS without requiring an additional processor or hardware". Appropriate correction or specific reference as to where the claimed invention is disclosed in the Specification is required.

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Claims 8-16, 24-26, and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner does not find limitations of the claimed invention in the Specification. For example, Examiner does not find the limitation "when a message from an authorized party is not received at a BIOS; booting the system without optional features" as disclosed in claim 24 (see similar language in claim 8). Appropriate correction or specific reference as to where the claimed invention is disclosed in the Specification is required.

Claims 24-26 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant claims "when a message from an authorized party is not received at a BIOS: *booting a system without optional features*". Not only does Examiner fail to find support for the limitation in the Specification, Examiner also fails to see how such a situation is enabled.

A system, such as the one described by Applicant, should always have optional features. For example, the system should always have a power control means (e.g. power button) in which the power may be turned on and off. Further, a system should have memory which may be optionally set as on/off (i.e. 1/0), a plethora of electrical signals which may be high/low, a video display which may be programmed in accordance with optional features, etc. From at least the above, Examiner submits that the expansive language used by Applicant (i.e. "booting the system without optional features") is not enabled. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner is unaware of the meaning of "without requiring an *additional* processor or hardware".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,8,17,24, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Tello, U.S. Patent No. 6,463,537.

As per claims 1,8,17,24, and 27, the applicant describes a method comprising the following limitations which are met by Tello:

a) receiving, at a BIOS, a message from an authorized party, wherein the authorized party is selected from a group of authorized parties consisting of a manufacturer, an original equipment manufacturer, and a lessor (Col 4, lines 11-37);

b) authenticating the message (Col 4, lines 11-37);

c) when the message has been successfully authenticated, controlling a state of an optional feature of a system resource, using the BIOS, according to the message, wherein the message

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comprises information to determine the optional feature, and wherein the message further comprises a digital signature (Col 4, lines 11-37);

d) when the message fails the authenticating, then discarding the message (Col 4, lines 11-37).

Examiner notes that the above rejection is based on a separate passage and separate interpretation of Tello than the 103(a) rejection of Tello in view of McKnight (see below).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,5,8,17,21,24-25, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis, U.S. Patent No. 5,844,986.

As per claims 1,8,17,24, and 27, the applicant describes a method comprising the following limitations which are met by Davis:

a) receiving, at a BIOS, a message from an authorized party, wherein the authorized party is selected from a group of authorized parties consisting of a manufacturer, an original equipment manufacturer, and a lessor (Col 3, line 38 to Col 4, line 18);

b) authenticating the message (Col 3, line 38 to Col 4, line 18);

c) when the message has been successfully authenticated, controlling a state of an optional feature of a system resource, using the BIOS, according to the message, wherein the message comprises information to determine the optional feature, and wherein the message further comprises a digital signature (Col 3, line 38 to Col 4, line 18);

d) when the message fails the authenticating, then discarding the message (Col 3, line 38 to Col 4, line 18).

As per claims 5,21, and 25, the applicant describes the method of claims 1,17, and 24, which are met by Davis, with the following limitation which is also met by Davis:

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Further comprising splicing the content of the message into an execution path of the BIOS, wherein the splicing comprises at least one of modifying the BIOS or erasing a portion of the BIOS, in response to the message (Col 3, line 38 to Col 4, line 18).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,8-14,17-20,24,27-28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tello in view of McKnight, U.S. Patent Application No. 2002/0165819.

As per claims 1,8,17,24, and 27, the applicant describes a method comprising the following limitations which are met by Tello in view of McKnight:

a) receiving, at a BIOS, a message from an authorized party, wherein the authorized party is selected from a group of authorized parties consisting of a manufacturer, an original equipment manufacturer, and a lessor (Tello: Col 31, lines 29-60; McKnight [0005]);

b) authenticating the message (Tello: Col 31, lines 29-60);

c) when the message has been successfully authenticated, controlling a state of an optional feature of a system resource, using the BIOS, according to the message, wherein the message comprises information to determine the optional feature, and wherein the message further comprises a digital signature (Tello: Col 31, lines 29-60);

d) when the message fails the authenticating, then discarding the message (Tello: Col 31, lines 29-60).

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Tello discloses a method, which meets limitations of the above claim, and in which a message is received at a BIOS from a party in order to configure a system such that certain resources are enabled. However, Tello appears to be silent as to the party being a manufacturer, original equipment manufacturer, or lessor. McKnight discloses the idea that a lessor may configure a system such that certain resources are enabled. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of McKnight with those of Tello and allow a lessor to configure a system in accordance with the teachings of Tello because doing so provides a convenient and secure way to enable certain resources.

As per claims 2,11-12,18, and 32, the applicant describes the method of claims 1,8, and 17, which are met by Tello in view of McKnight, with the following limitation which is also met by Tello:

Further comprising verifying an identifier in the message against a unique system identifier (Col 5, lines 15-48; Col 9, lines 26-30).

As per claims 9 and 10, the applicant describes the system of claim 8, which is met by Tello in view of McKnight, with the following limitation which is also met by Tello:

Further comprising a write-once non-volatile unit for storing a public key accessible by the BIOS (Col 15, lines 6-13).

As per claims 13 and 14, the applicant describes the system of claim 8, which is met by Tello in view of McKnight, with the following limitation which is also met by Tello:

Further comprising a secure non-volatile location for storing at least one of the optional features to be enabled, the location being readable and writable by the BIOS (Col 26, lines 18-43).

As per claims 3-4,19-20, and 28, the applicant describes the system of claims 1,17, and 27, which are met by Tello in view of McKnight, with the following limitation which is also met by Tello:



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Further comprising writing the message into a secure non-volatile location (Col 26, line 63 to Col 27, line 8; Col 31, lines 29-60).

Claims 6,16,22,26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tello in view of McKnight in further view of Ala-Laurila, U.S. Patent No. 6,704,789.

As per claims 6,16,22,26, and 30, the applicant describes the method of claims 1,8,17,24, and 27, which are met by Tello in view of McKnight, with the following limitation which is met by Tello and Ala-Laurila:

Further comprising loading and executing content of the message using the BIOS at run-time, wherein the message is received via a network transmission (Tello: Col 31, lines 29-60; Ala-Laurila: Fig 3A);

Tello in view of McKnight disclose all the limitations of claims 1,8, and 17. Tello in view of McKnight also discloses loading and executing content of the message using the BIOS at run-time. Tello in view of McKnight does not disclose that the message is sent through a network transmission. Tello in view of McKnight is silent as to how the communication between the smartcard and the system takes place. Ala-Laurila discloses the well-known idea that communication between two entities can take place through a network environment. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Ala-Laurila with those of Tello in view of McKnight because sending information through a network transmission is well-known as an effective method of transmitting data.

Claims 7,15, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tello in view of McKnight in further view of Obata, U.S. Patent Application No. 2001/0025312.

As per claims 7,15, and 23, the applicant describes the method of claims 1,8, and 17, which are met by Tello in view of McKnight, with the following limitation which is met by Obata:

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Further comprising updating a feature set of the system BIOS according to the message (Obata: Fig 2);

Tello in view of McKnight appears to fail to teach updating a feature set of the system BIOS according to the message. Obata discloses the idea of updating the status of system features in a table-like fashion. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Obata with those of Tello in view of McKnight because updating a feature set provides a convenient way to check the status of resources within a system.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tello in view of McKnight in further view of Alexander, U.S. Patent No. 6,393,559.

As per claim 29, the applicant describes the system of claim 28, which is met by Tello in view of McKnight, with the following limitation which is met by Alexander:

Wherein the system is to be rebooted to enable the BIOS to control the at least one of the optional features according to the received secure message (Alexander: Col 3, lines 23-46);

Tello in view of McKnight discloses all limitations of claim 28. Tello in view of McKnight, however, does not disclose all the limitations of the above claim. Alexander discloses the idea of rebooting rectification of possible a software or hardware glitch and to ensure proper initialization and control for the BIOS. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Alexander with those of Tello in view of McKnight and incorporate the functionality of rebooting to ensure proper initialization and rectify possible glitches.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tello in view of McKnight in further view of Lau, U.S. Patent Application No. 2003/0052906.

As per claim 31, the applicant describes the system of claim 27, which is met by Tello in view of McKnight, with the following limitation which is met by Lau:

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Wherein the secure message comprises executable code to be used as a Dynamically Loaded Library (DLL), and wherein the DLL is to be stored in non-volatile storage coupled to the BIOS, and wherein the DLL is to be loaded by the BIOS at run-time (Lau: [0037]);

Tello in view of McKnight discloses all the limitations of claim 27. Tello in view of McKnight, however, fails to disclose the use of a DLL. Lau discloses the functionality loading a DLL to provide plug-in support. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Lau with those of Tello in view of McKnight in order to make the system more robust by incorporating the functionality of providing plug-in support.

Claims 5,21, and 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tello in view of McKnight in further view of Merkin, U.S. Patent No. 6,584,561.

As per claims 5,21, and 25, the applicant discloses the limitations of claims 1,17, and 24, which are met by Tello in view of McKnight (see above), with the following limitation which is met by Merkin:

Further comprising slicing the content of the message into an execution path of the BIOS (Col 2, lines 27-34);

Tello in view of McKnight discloses all the limitations of independent claim 1. However, Tello in view of McKnight fails to disclose splicing the content of the message. Merkin discloses a boot system similar to Tello's system with the main difference that Merkin's system revolves around a CD boot while Tello's system revolves around a smart card boot. Merkin discloses that the message received from the CD includes identification data and boot software. Once the data has been authenticated, the boot software is split from the rest of the message and alone "the boot software is copied back to the execution part" (Col 2, lines 20-21). It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Merkin with those of Tello in view of McKnight and splice the content of the message into an execution path of the BIOS because only the necessary data needs to be sent to the execution path of the BIOS.

### ***Response to Arguments***

Applicant's arguments filed 3/20/06 with respect to the 112, first paragraph, rejection of claims 24-26 have been fully considered but they are not persuasive. Applicant argues 1) that the limitation "when a message from an authorized party is not received at a BIOS: booting the system without optional features" is inherent and 2) that at no time does Applicant teach that the system does not boot.

Regarding 1), Examiner disagrees that the limitation is inherent. In order for a limitation to be inherent, the method must require the limitation. In the instant situation, the method does not require the limitation. For example, a message from an authorized party may always be received at a BIOS. Further when a message is not received at a BIOS, the system may boot with optional features. Thus, Examiner has shown that the limitation is not required by the method, and therefore *not inherent*. Regarding 2), failure to teach that a system does not boot does not provide support for the limitation "when a message from an authorized party is not received at a BIOS: booting the system without optional features".

Applicant's arguments with respect to the 112, first paragraph, rejection of claims 27-31 have been fully considered and are persuasive. The 112, first paragraph, rejection of claims 27-31 has been withdrawn.

Applicant's arguments with respect to the prior art rejections of claims 1-31 have been fully considered, but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an

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application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KS

  
**EMMANUEL L. MOISE**  
**SUPERVISORY PATENT EXAMINER**